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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/540,993

08/15/2005

Karel Dolezal

J507-005 US

8995

21706 7590 11/15/2010  
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EXAMINER

MCINTOSH III, TRAVISS C

ART UNIT

PAPER NUMBER

1623

MAIL DATE

DELIVERY MODE

11/15/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/540,993	<b>Applicant(s)</b> DOLEZAL ET AL.	
	<b>Examiner</b> TRAVISS C. MCINTOSH III	<b>Art Unit</b> 1623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2, 15-17 and 22 is/are pending in the application.
- 4a) Of the above claim(s) 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2 and 15-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

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### **DETAILED ACTION**

The Amendment filed 9/14/2010 has been received, entered into the record, and carefully considered. The following information provided in the amendment affects the instant application by:

Claim 2 has been amended.

Claims 1, 3-14, and 18-21 are canceled.

Claim 22 stands as being withdrawn.

Remarks drawn to rejections of Office Action mailed September 18, 2009 include:

102(b) rejection: which has been overcome by applicant's amendments and has been withdrawn.

103(a) rejection: which has been overcome by applicant's amendments and has been withdrawn.

An action on the merits of claims 2 and 15-17 is contained herein below. The text of those sections of Title 35, US Code which are not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 2 and 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,773,423.

US '423 discloses N<sup>6</sup>-(3-iodobenzyl)-9-[β-D-ribofuranosyl]adenine in columns 55-56, example 41. This is seen to be equivalent to 6-(3-iodobenzylamino)purine riboside as set forth in line 4 of claim 2 of the instant application. Likewise, the '423 patent discloses compositions comprising the same - see Table 2 in columns 63-64. The intended use is not seen to make patentable the compositions claims as the prior art's compositions could have functioned in the same way as the instant compositions, as they contain the same claimed amount of the same claimed agents, and thus are seen to be the same. While the examiner has made an effort to indicate all of the species which are contained in the reference and anticipate the instant claims, it is noted that "A generic claim cannot be allowed to an applicant if the prior art discloses a species falling within the claimed genus." The species in that case will anticipate the genus of the instant claims. In re Slayter, 276 F.2d 408, 411, 125 USPQ 345, 347 (CCPA 1960); In re Gosteli, 872 F.2d 1008, 10 USPQ2d 1614 (Fed. Cir. 1989). As such, applicants are encouraged to review the document in its entirety to remove all species in their claims which are disclosed in the reference.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 2 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,773,423 as set forth supra.

The '423 patent discloses various compounds as noted supra. It is noted, as set forth in previous office actions, that it is well settled that compounds that differ only as positional isomers are not deemed patentably distinct absent evidence of superior, unexpected results. See *In re Crounse* 150 USPQ 554; *Ex parte Engelhardt* 208 USPQ 343 regarding position isomerism. As such, 6-(2-iodobenzylamino) purine riboside and 6-(4-iodobenzylamino) purine

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riboside are seen to be obvious variants of 6-(3-iodobenzylamino) purine riboside, as they are positional isomers thereof.

Claims 2 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 4,514,405.

The '405 patent discloses various compounds such as 6-(2-fluorobenzylamino)purine riboside (see column 3, lines 26-52 for example). It is noted, as set forth in previous office actions, that it is well settled that compounds that differ only as positional isomers are not deemed patentably distinct absent evidence of superior, unexpected results. See *In re Crounse* 150 USPQ 554; *Ex parte Engelhardt* 208 USPQ 343 regarding position isomerism. As such, 6-(3-fluorobenzylamino) purine riboside and 6-(4-fluorobenzylamino) purine riboside are seen to be obvious variants of 6-(2-fluorobenzylamino) purine riboside, as they are positional isomers thereof.

### ***Conclusion***

The examiner would like to note that while the following list is not exhaustive as it relates to that being claimed, the following species are deemed allowable:

- 6-(2-acetylbenzylamino)purine riboside;
- 6-(3-acetylbenzylamino)purine riboside;
- 6-(4-acetylbenzylamino)purine riboside;
- 6-(2-acetoxybenzylamino)purine riboside;
- 6-(3-acetoxybenzylamino)purine riboside;

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6-(4-acetoxybenzylamino)purine riboside;  
6-(2-sulphobenzylamino)purine riboside;  
6-(3-sulphobenzylamino)purine riboside; and  
6-(4-sulphobenzylamino)purine riboside

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TRAVISS C. MCINTOSH III whose telephone number is (571)272-0657. The examiner can normally be reached on M-F 9:30-6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shaojia A. Jiang can be reached on 571-272-0627. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Traviss C McIntosh III/  
Primary Examiner, Art Unit 1623  
November 10, 2010